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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,675	08/06/2001	Michael W. Wood	MOODY 20	1529
24258	7590	11/19/2003		
JOHN EDWARD ROETHEL 2290 S. JONES BLVD. #100 LAS VEGAS, NV 89146			EXAMINER MARKS, CHRISTINA M	
			ART UNIT 3713	PAPER NUMBER
			DATE MAILED: 11/19/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/923,675

Applicant(s)

WOOD ET AL. *CW*

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

The objection to the drawings for not including a reference sign for the BET MAX location has been withdrawn due to the amendment filed 12 September 2003.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes, Jr. et al. (US Patent No. 5,957,774) in view of Schneider (US Patent No. 6,089,976) further in view of Faciglia (US Patent No. 5,935,002).

Holmes, Jr. et al. disclose a method of playing a video poker game having a bonus award associated with the poker game (Abstract). A predetermined arrangement of five cards (FIG 1-A, reference 220) is established as a winning bonus award and is thus used as the player's matching cards for the game (Column 3, lines 45-51). Holmes, Jr. et al. also contemplate the use of the predetermined arrangement of cards based upon the Royal Flush, as the Royal Flush typically represents the highest payout (thus has the least likelihood) for poker (Column 1, lines 57-67; Column 2, lines 14-17). The player is then dealt a first initial five-card hand (Column 3, line 47) and it is determined whether any of the first initial five cards match any of the predetermined cards (Column 3, lines 48-51). After the initial five cards are analyzed to determine if a win has occurred on the deal, the player is then allowed to play out the first initial five card hand according to the convention rules of poker (Column 3, lines 7-12). Holmes, Jr. et al. also disclose that the player must make a wager in order to be eligible to participate in the game (Column 1, lines 24-26).

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Holmes, Jr. et al. do not disclose noting the matched cards as they occur or continuing to deal subsequent hands and allowing the player to play out each of the subsequent hands in order to continue trying to match cards with the predetermined arrangement.

However, Schneider et al. discloses a bonusing method wherein a player plays multiple rounds of a game in an attempt to achieve a match in order to win a secondary award (Abstract). Unlike Holmes, Jr. et al., the quest to match does not end after one hand and the process continues until an actual match is achieved (Abstract). The player receives a number of selections that continue until a match occurs at which time the match is noted by displaying it to the player (Abstract). When a match has been made, it will be determined the bonus award which will be awarded to the player (Column 6, lines 11-23). Further, using the match method of Schneider et al., an advantage is that the player has two opportunities to win (Column 3, lines 40-45) as well as increased opportunities to achieve a match.

It would have been obvious to one of ordinary skill in the art to apply the teachings of Schneider et al. to the system of Holmes, Jr. et al. Holmes, Jr. et al. allow the player only one opportunity to make a match, thus limiting the excitement and continued anticipation associated with the game. Alternatively, Schneider et al. allows a player to continue to attempt to make a match until one is actually made. One of ordinary skill in the art would be motivated to make this incorporation in order to provide the player with two opportunities to win, as taught by Schneider et al. as well as increase the player enjoyment and anticipation that would be associated with multiple opportunities to make a match in a bonus environment. By limiting the hand to only one try, as Holmes, Jr. et al. does, players could quickly become discouraged, as the actual chance of achieving all the matches in one hand is very low. Thus, by allowing the matching game of Holmes, Jr. et al. to occur until a match occurs, as taught by Schneider et al., the player would feel a greater amount of excitement and encouragement at the ability to

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continue play until an actual match occurs. Otherwise, players may just give up at the seemingly impossible task of matching all cards in one try.

However, in application of the teachings of Schneider et al. to Holmes et al., there is no disclosure as to how the bonus award would be calculated. In Holmes et al., the bonus award is given if the hand is matched and is not given if the hand is not matched. In Schneider et al., the bonus is given upon the occurrence of a match. One of ordinary skill in the art would understand that both of these functions of awarding would not be realistic in the combination of the two references as the multiple chances of Schneider et al. would not be conducive with an award only on one hand, as disclosed by Holmes, Jr. et al. Likewise, automating an award based on the match would not be conducive, as the player would be matching cards, not values.

Falciglia teaches of a game where the player makes an attempt to match the indicia chosen by the machine to preset indicia. The goal of the game is thus to make the desirable matches in order to obtain an award. Falciglia also teaches of basing the award received in the secondary game on the number of tries that it took for all of the predetermined arrangement of criteria to be matched (Column 6, lines 11-23). These payouts are based on a winnings schedule that provides a balance between winning, losing and investing for each spin (Column 6, lines 11-13).

Regarding claim 5, Falciglia does not disclose the exact payable as claimed; however, it is notoriously well known in the art to adjust pay tables for a variety of reasons including attempts to attract players with high payouts and payouts that would allow the player to perceive a greater chance of winning an award. It would have been obvious to one of ordinary skill in the art to do so and make adjustments to pay tables as long as the payable keeps the appropriate house advantage while remaining fair to the player and provide a proper balance between

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winning, losing, and investing for each spin as disclosed as desirable for a winnings schedule by Falciglia.

Further, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the payout teachings of Falciglia into the system of Holmes, Jr. et al. in view of Schneider et al. in order to base the award on the number of hands required to obtain a match. The flaws in the payout methods of Holmes, Jr. et al. in combination of Schneider have been identified above. By incorporating a payout associated with multiple chances for the player to accumulate a win and using a payable based upon the number of chances needed to achieve the winning hand, as taught by Falciglia, the method of Holmes, Jr. et al. in view of Schneider et al. would achieve a payable that would be desirable to the combination wherein the payout would not be associated with the match, but the amount of turns taken to acquire the match in order to obtain a winnings schedule that provides a balance between winning, losing and investing for each spin (Column 6, lines 11-13) as disclosed as desirable by Falciglia. Thus the incorporation of the teachings of Falciglia would work to correct the improbable payouts associated with Holmes, Jr. et al in view of Schneider et al. thus motivating a skilled artisan to incorporate such a feature.

### ***Response to Arguments***

Applicant's arguments, see page 7, filed 12 September 2003, with respect to the rejection(s) of claim(s) 1-7 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a different interpretation as well as additional prior art.

Regarding Applicant's argument that Falciglia does not allow the game to continue until a match occurs, the Examiner agrees but notes this deficiency has been corrected by the teachings of Schneider et al.

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Regarding Applicant's argument that bingo and video-poker are non-analogous art, the Examiner respectfully disagrees and points out that the concept of indicia matching was the teaching that was garnished from the bingo reference in application to an indicia-matching facet of the poker reference and thus these references are analogous.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-930<sup>6</sup>~~7~~.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.



cmm  
November 13, 2003



Teresa Walberg  
Supervisory Patent Examiner  
Group 3700